# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/488,511 | 01/20/2000 | Yoshinori Aoki | 12819-(JA999-099) | 4532 |

7590    05/23/2006

Leopold Presser
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY   11530

| EXAMINER |
|---|
| STORK, KYLE R |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2178 | |

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
| :--- | :--- | :--- |
| **Office Action Summary** | 09/488,511 | AOKI ET AL. |
| | **Examiner** | **Art Unit** | |
| | Kyle R. Stork | 2178 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>27 March 2006</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1,2,4-10 and 12-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-10 and 12-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

## DETAILED ACTION

1.      This non-final office action is in response to the amendment filed 27 March 2006.

2.      Claims 1-2, 4-10, and 12-20 are pending.  Claims 1, 9, and 16 are independent

claims.

## *Claim Rejections - 35 USC § 112*

3.      Claims 1-2 and 4-8 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

        With respect to claim 1, the applicant claims a enabling a request for a web page

that the user, "intends to customize (lines 4-5)."  It is indefinite because it is not possible

to determine the user's intent prior to the request.  The examiner suggests amending

the limitation to be:  "means for enabling said user to request an original Web page for

said user to customize."

        Claims 2 and 4-8 are rejected based upon their dependency upon a rejected

base claim.

## *Claim Rejections - 35 USC § 103*

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 1-2,4-10, and 12-20 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Lowery et al. (US 5894554, filed 23 April 1996, hereafter Lowery)

and further in view of Lemay (Microsoft® Frontpage™ 98, 1997).

Regarding independent claim 1, Lowery discloses a system for customizing a

Web page by using at least one client computer on which a browser for browsing a Web

page runs (see Abstract, lines 1-2, the invention creates and manages custom Web

pages), said system comprising:

means for enabling said user to request an original Web page that the user

intends to customized (Abstract discloses sending a generation request (line 5), which

would include this limitation);

means for embedding a customizing program in said requested original web

page (in col. 2, lines 25-35, dynamic generation means are embedded);

means for receiving said requested original Web page in which said program for

customizing a page is embedded (col. 2, lines 25-35, dynamic generation passes page

to generator); web browser means for displaying said received original Web page (Web

page is displayed, which inherently requires a browser; means for having said program

display a control panel for a customizing operation (col. 7, lines 45-60, tools like Visual

Basic and Visual C++ or PowerBuilder allow customization);

means for customizing said original Web page according to a customizing

operation by a user using said control panel while said original Web page is retained for

other users(Visual Basic, Visual C++ and PowerBuilder preserved backups of original

web pages); and

means for storing data pertaining to said customizing operation, wherein said

web page is dynamically restored with said customizing data when subsequently

accessed by said user (Visual Basic, Visual C++ and PowerBuilder fulfilled this

limitation).

However, Lowery fails to disclose a user requesting an existing web page and

further being able to customize the web page. However, Lemay discloses a user

requesting an existing web page and further being able to customize the web page

(page 37, Q&A, question 2: Here, a user is able to download preexisting web pages

from a website so that the user may further enhance the web pages using FrontPage™;

38-78: Here, customization techniques for downloaded content are disclosed). It would

have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to have combined Lowery's method with Lemay's method, since it would have

allowed a user to enhance imported pages (Lemay: page 37).

Lemay further fails to specifically disclose modification of the web pages at a

client computer. However, Lowery discloses modification of the web pages at a client

computer (page 53: Here, Lowery teaches the user modification of pages residing on

the hard drive of a client computer). It would have been obvious to one of ordinary skill

in the art at the time of the applicant's invention to have combined Lowery with Lemay,

since it would have allowed a user to incrementally modify pages without disturbing the

posted web pages.

Regarding dependent claim 2, Lowery further discloses a system wherein said means for requesting a Web page is a means for requesting a page from a Web server via a server or for requesting a locally stored Web page (see fig. 4, items 200-201).

Regarding dependent claim 4, Lowery further discloses a system wherein said means for storing data on a customizing operation is a means for storing said data on a server (see fig. 4).

Regarding dependent claim 5, Lowery further discloses a system wherein said system further comprises: means for having another computer request a Web page to be customized (see fig. 4; page servers vs. web server); means for having another computer receive said requested Web page in which a program for customizing a page is embedded (see fig. 4; page servers); means for having another computer display said received Web page by a browser (page is displayed, which inherently requires a browser); means for having said program display a control panel for a customizing operation(col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder allow customization); and means for having said program, based on data of a customizing operation already performed on said Web page, reflect a customizing operation performed on said Web page on a browser(col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder allow customization; this is reflected as in fig. 4 from web server to page server).

Regarding dependent claim 6, Lowery further discloses a system wherein said system further comprises the means for further customizing a Web page according to a customizing operation by a user using said control panel from said another

computer(see use of Web client on Fig. 4 and col. 7, lines 45-60, tools like Visual Basic

and Visual C++ or PowerBuilder).

Regarding dependent claim 7, Lowery further discloses a system wherein said

program is executable independent of any operating system or web browser (col. 7,

lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder can be run on

multiple OSes as there are multiple relevant tools and do not require a web browser).

Regarding dependent claim 8, Lowery further discloses a system wherein said

system comprises a means for immediately reflecting a result of a customizing

operation on a browser (see Abstract, lines 12-18, the Web pages are dynamically

generated).

Regarding independent claim 9, it is a method which is performed by the system

of claim 1 and is rejected under similar rationale.

Regarding dependent claim 10, it is a method which is performed by the system

of claim 2 and is rejected under similar rationale.

Regarding dependent claim 12, it is a method which is performed by the system

of claim 4 and is rejected under similar rationale.

Regarding dependent claim 14, it is a method which is performed by the system

of claim 5 and is rejected under similar rationale.

Regarding dependent claim 15, it is a method which is performed by the system

of claim 6 and is rejected under similar rationale.

Regarding dependent claim 16, it is a medium that contains a method that is

performed by the system of claim 7 and is rejected under similar rationale.

Regarding dependent claim 17, Lowery discloses a system wherein said customizing operation via said control panel includes one or more of adding an object, changing an attribute of an object or deleting an object (customizing must logically involve changing an object in some way and these are all the ways in which an object can change).

Regarding dependent claim 18, Lowery further discloses a system wherein said customizing operation is performed without changing an existing web server providing said original Web page or said web browser (the customization operation occurs at the Web client, number 200, part of fig. 4, and hence does not affect the Web server directly).

Regarding dependent claim 19, it is a method that is performed by the system of claim 17 and is rejected under similar rationale.

Regarding dependent claim 20, it is a medium that contains a method that is performed by the system of claim 7 and is rejected under similar rationale.

### *Response to Arguments*

6.      Applicant's arguments filed 27 March 2005 have been fully considered but they are not persuasive.

The applicant argues that Lemay fails to teach the customization data stored on a client computer (page 12). However, the examiner respectfully disagrees. Lemay teaches web pages stored on a client computer that are modified by a user (pages 53-78).

Further, the applicant argues that the examiner has used impermissible hindsight in combining Lowery and Lemay. However, the examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle R Stork
Patent Examiner
Art Unit 2178

krs

**CESAR PAULA**
**PRIMARY EXAMINER**